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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,693	08/29/2003	Mark A. Shadle	Shadle 08/03	9213
29988	7590	03/25/2004	EXAMINER	
THOMAS B. RYAN HARTER, SECREST & EMERY LLP 1600 BAUSCH & LOMB PLACE ROCHESTER, NY 14604-2711			HENDERSON, MARK T	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/651,693

Applicant(s)

SHADLE ET AL.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 18-33 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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1. Claims 1-3, 5-15, and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Good et al (5,912,759).

Good et al discloses in Fig. 7 and 8, an irreversible display comprising: an aluminum metal film (130) which can be shaped and sized (thickness) to clear at a particular rate (Col. 7, lines 60-65) ; a display window (128) aligned with the metal film (130); an colored (Col. 2, lines 60-65) ink patch or information indicium (132) aligned with the display window and obscured by metal film (130); wherein the window provides access to the metal film for exposing the metal film to a chemical agent (114) that clears a portion of the film; a substrate (134) supporting the metal film (130); wherein the metal film is vapor deposited onto the substrate (Col. 8, lines 25-30), wherein the substrate is transparent (Col. 7, lines 47-53, wherein the substrate can be a window); a top substrate (126) and a bottom substrate (134), wherein the top substrate has a window (128); wherein the indicium (132) is supported adjacent to the bottom substrate (134) and is separated from the top substrate by the metal film (130); wherein the window (128) is also the transport layer, wherein an end user applies pressure to force the clear agent (114) to the metal film (130) as stated in Col. 7, lines 29-38; a protective layer (118 and 112) laid out in a pattern on the metal film (130).

In regards to **Claim 11**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making,

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the intended use must result in a manipulative difference as compared to the prior art. Therefore, the color patch of Good et al is capable of contrasting to the color of the metal film.

2. Claims 20-27, 30-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitchell et al (6,243,192).

Mitchell et al discloses in Fig. 16-18, an irreversible display comprising: an opaque metal film (274) having an adjustable thickness (Col. 3, lines 29-33) which can be either zinc or aluminum (Col 16, lines 25-33) supported by a substrate (278 or 280); a transparent (Col. 13, lines 8-11) protective layer (272) located between the display window (in 278) and laid out in a pattern on the metal film (274); a first portion (shown in Fig. 17, in which the left periphery of the metal film is the first portion) that is not covered by the protective layer (272) being accessible to the clearing agent; a second portion (top surface of the metal film (274) that is covered by the protective layer being temporarily inaccessible to the clearing agent; wherein the first and second portions of the metal film being arranged for producing a viewable pattern (seen in Fig. 18, wherein the graphics layer (284) will be exposed); in which the substrate is one of a top substrate (278) having a window (seen in Fig. 16), and a bottom substrate (280) between which a metal film (274) is mounted; wherein the display window is formed by an opening through which the clearing agent (276) can be applied to the first portion of the metal film (seen in Fig. 18); wherein the clearing agent (276) is transparent (Col. 13, lines 25-28) and is confined within a reservoir (292, seen in Fig. 16 and 17).

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al in view of Mitchell et al

Good et al discloses an irreversible display comprising all the elements as claimed in Claims 1 and 14, and as set forth above.

However, Good et al does not disclose: wherein the metal film is made out zinc.

Mitchell et al discloses a metal film which can be made out of zinc or copper (Col. 16, lines 25-33).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Good et al's display with a metal film made of zinc as taught by Mitchell et al for providing an alternative metal that reacts with a clearing agent.

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4. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell et al.

Mitchell et al discloses an irreversible display comprising all the elements as claimed in Claim 20, and as set forth above. Mitchell further discloses a spacer (seen in Fig. 17) which spaces the clearing agent from the metal film.

However, Mitchell does not disclose: where the clearing agent overlies the metal film.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the clearing agent at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. Applicant has not disclosed that the location of the clearing agent relative to the metal film is critical to his invention, and the invention would work equally as well with the clearing agent any desirable location in which it can access the metal film.

*Allowable Subject Matter*

5. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

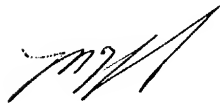
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***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Shadle et al (GB '611), Green et al, Good et al, ('492), Shadle et al ('691), Shadle et al ('122), and Cox disclose similar displays.

**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

March 21, 2004



**Daniel W. Howell  
Primary Examiner  
Art Unit 3722**